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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097245,493	02/05/99	CINCOTTA	D 2435.1

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NEW YORK NY 10112

EXAMINER

NGUYEN, N

ART UNIT	PAPER NUMBER
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2764

DATE MAILED: 06/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/245,493

Applicant(s)
Cincotta

Examiner
Nga B. Nguyen

Group Art Unit
2764



☒ Responsive to communication(s) filed on Feb 5, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-25 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-25 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. This Office Action is the answer to the Amendment received on April 10, 2000 , which paper has been placed of record in the file.
2. Claims 6-25 are added. Claims 1-25 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 1-5 have been considered but are not persuasive. In the argument, Applicant stated that the central computer in Walker's invention is a passive "middle man" which conveys information between buyers to sellers, and does nothing else. Examiner totally disagrees. In fact, the central computer serves as a trusted third party administrator to resolve contract between buyers and sellers. Contracts are executed between third party, buyers and sellers in which third party collect funds of buyers and then pay to the sellers. Moreover, central computer guarantees buyers pay for the goods, determines the seller's capacity to satisfy the conditions of the purchase offer and performs matching buyers and sellers (see column 7, line 13-column 8, lines 14). The central computer is not a passive "middle man" as stated by Applicant. Therefore, Examiner decides to maintain the rejection on claims 1-5 as discuss in the previous Office action.

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4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1-5 and 24 are rejected under 35 U.S.C. 102(a) as being anticipated by Walker et al, U.S. Patent No. 5,794,207.

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Regarding claim 1, Walker discloses a method, to be administered by an administering entity, for allowing a plurality of participants to prepay for services or goods to be received at a later date from one of a plurality of specified providers, the method comprising the steps of:

executing contracts between the administering entity and each of the plurality of participants in which a contracting participant pays to the administering entity a cash amount and in return receives from the administering entity a promise to deliver at a future date a specified measure of services or goods, the services or goods to be provided by whichever of the plurality of specified providers the contracting participant selects (column 16, lines 12-63; column 19, lines 29-45 and column 21, lines 1-60);

determining, for each of the plurality of specified providers, a predicted total measure of services or goods that will be required from that provider by the aggregate of the plurality of participants (column 31, lines 15-67); and

executing contracts between the administering entity and each of the plurality of specified providers in which the administering entity pays to a contracting provider a cash amount and in return receives from the contracting provider a promise to deliver a specified measure or services or goods (column 21, lines 1-15 and column 29, lines 7-17).

Regarding claim 2, Walker discloses the administering entity ascertains the measure of services or goods to be specified in each contract with a provider in accordance with the predicted total measure of services or goods that will be required from that provider (column 19, lines 12-54).

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Claims 3 and 4 are written in means and contain the same limitations as claims 1 and 2, respectively, therefore, are rejected by the same rationale.

Regarding claim 5, Walker discloses a financial data processing system for allowing a plurality of participants to prepay for services or goods to be received at a later date from one of a plurality of specified providers, the choice of which of the plurality of providers will deliver the services or goods being made by a participant at the time the goods and services are to be delivered:

a machine-readable storage devices which stores data indicating measures of services or goods for which each participant has prepaid and measures of services or goods which each provider has contracted to provide (column 12, lines 54-67);

a processing circuit for determining, for each of the providers, a predicted total measure of services or goods that will be required from that provider by the aggregate of the plurality of participants (column 12, lines 3-53).

Claims 24 is written in computer software and contain the same limitations as claims 1, therefore are rejected by the same rationale.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Walker et al, U.S. Patent No. 5,794,207 in view of Mottola et al, U.S. Patent No. 5,809,484.

Regarding claim 6, Walker discloses a method, to be administered by an administering entity, for allowing a plurality of participants to prepay for services or goods to be received at a later date from one of a plurality of specified providers, the method comprising the steps of:

executing contracts between the administering entity and each of the plurality of participants in which a contracting participant pays to the administering entity a cash amount and in return receives from the administering entity a promise to deliver at a future date a specified measure of services or goods, the services or goods to be provided by whichever of the plurality of specified providers the contracting participant selects (column 16, lines 12-63; column 19, lines 29-45 and column 21, lines 1-60);

determining, for each of the plurality of specified providers, a predicted total measure of services or goods that will be required from that provider by the aggregate of the plurality of participants (column 31, lines 15-67); and

executing contracts between the administering entity and each of the plurality of specified providers in which the administering entity pays to a contracting provider a cash amount and in return receives from the contracting provider a promise to deliver a specified measure or services or goods (column 21, lines 1-15 and column 29, lines 7-17).

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However, Walker does not teach services contains educational service. Mottola teaches service is educational service (see abstract). It would have been obvious to one with ordinary skill in the art at the time the invention was made to include educational service in Walker's method for the purpose of providing participants such as parents can prepay tuition for college education to be received when their children reaches college age from any one of several colleges.

Regarding claim 7, Mottola discloses the participants designate beneficiaries to whom the educational services will be provided (column 13, lines 31-55) .

Regarding claim 8, Mottola discloses a beneficiary is designated by a participant at the time a contract between that participant and the administering entity is executed (column 13, lines 43-50).

Regarding claim 9, Mottola discloses the contracts between the administering entity and the participants comprise participant option contracts and the contracts between the educational institutions and the administering entity comprise institution option contracts (columns 14-15).

Regarding claim 10, Mottola discloses the contracts between the administering entity and the participants comprise participant option contracts and the contracts between the educational institutions and the administering entity comprise institution forward contracts (columns 14-15).

Regarding claim 11, Mottola discloses the contracts between the administering entity and the participants comprise participant forward contracts and the contracts between the educational institutions and the administering entity comprise institution option contracts (columns 14-15).

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Regarding claim 12, Mottola discloses the contracts between the administering entity and the participants comprise participant forward contracts and the contracts between the educational institutions and the administering entity comprise institution forward contracts (columns 14-15).

Regarding claims 13-14, Mottola discloses the participant option contracts are deep-in-the-money option contracts (column 17, lines 7-43).

Regarding claim 15, Walker discloses the determination process for each of the plurality of specified educational institutions comprises:

- examining an educational institution data record (column 19, lines 13-45);

- examining a participant data record for each of the plurality of participants (column 17, lines 8-47);

- comparing the educational institution data record with each participant record to determine a predicted total measure of education that each participant will require from the particular education institution (column 18, lines 15-33); and

- summing the predicted total measure of education that each participant will require from the particular educational institution to determine for each of the plurality of specified educational institutions a predicted total measure of educational services that will be required from that educational institution by the aggregate of the plurality of participants (column 18, line 56-column 19, line 28).

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Regarding claim 16, Mottola discloses educational institution data records include statistical information describing the historical makeup of the particular educational institution's student body (column 6, lined 10-65).

Regarding claim 17, Mottola discloses statistical information includes information describing academic performance prior to admission (column 4, lines 10-15).

Regarding claim 18, Mottola discloses statistical information includes information describing scholastic aptitude test scores (column 4, lines 2-4).

Regarding claim 19, Mottola discloses statistical information includes information describing geographic origin of students (column 6, lines 38-50).

Regarding claim 20, Mottola discloses participants data records include data describing the compounding beneficiaries geographic locale (column 6, lines 38-50) .

Regarding claim 21, Mottola discloses participants data records include data describing the compounding beneficiaries academic performance (column 4, lines 15-30).

Regarding claim 22, Mottola discloses participants data records include data describing the compounding beneficiaries scholastic aptitude test scores (column 4, lines 2-4).

Regarding claim 23, Mottola discloses participants data records include data describing the measure of educational services that has been promised by the administrating entity to the particular participant (column 15, lines 29-40).

Claims 25 is written in computer software and contain the same limitations as claims 6, therefore are rejected by the same rationale.

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Conclusion

9. Claims **1-25** are rejected.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen, whose telephone number is (703)306-2901. The examiner can normally be reached on Monday-Friday from 7:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on (703)305-9768.

11. **Any response to this action should be mail to:**

Commissioner of Patents and Trademarks

c/o Technology Center 2700

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

or:

(703) 308-5397 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II,

2121 Crystal Drive, Arlington.

VA., Sixth Floor (Receptionist).

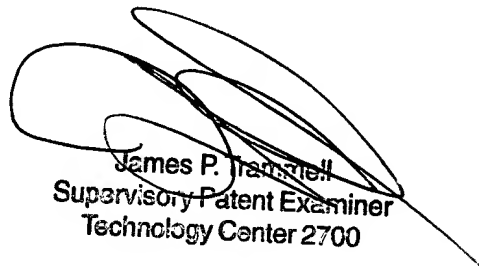
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)305-3900.

Nga B. Nguyen
June 16, 2000



James P. Transfield
Supervisory Patent Examiner
Technology Center 2700